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| 10/540,480      | 06/23/2005  | Hirozoh Tsuruta      | 025260-100          | 2983             |

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EXAMINER

MARCHESCHI, MICHAEL A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/540,480

Applicant(s)

TSURUTA ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The broad interpretation of a “coolant” is water (i.e. water is a coolant), thus claims 10-11 can be interpreted that the slurry further includes water. However, claims 1 and 2 already define that water is present, thus claims 10-11, as drafted, do not further limit claims 1 and 2, respectively, since water is a coolant and is within the scope of claims 10 and 11.

Claim 1 is rejected under 35 U.S.C. 103(a) as obvious over Mueller et al. for the same reason set forth in the previous office action which are incorporated herein by reference. This is not a new rejection because the claims were previously rejected under this statute, as an alternative rejection.

New claims 4, 5 and 10 are rejected under 35 U.S.C. 103(a) as obvious over Mueller et al.

With respect to the amount of water (claim 5), although not literally defined by Mueller et al., when taking into consideration the ranges of the fluoride, amine, base and abrasive components, the amount of water can be calculated by subtracting this total amount from 100%

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(since the water is the balance of the composition). When this is done, the amount of water is within the claimed range.

With respect to claim 10, as defined above in the objection, the claim can be broadly interpreted to define that water is present (since water is a coolant). Since the reference contains this component (and the claim does not specify the type of coolant), it reads on the broad interpretation of claim 10.

With respect to claim 4, with the claimed amount of water being obvious (see above-balance of the composition), when one calculates the mass ratio of the amount of amine to this amount of water, the claimed mass ratio is met.

New claim 3 is rejected under 35 U.S.C. 103(a) as obvious over Mueller et al., as applied to claim 1 above, and further in view of Tredinnick et al.

Tredinnick et al. teaches in the claims a conventional size for abrasive used in polishing compositions.

With respect to the abrasive size, although not defined by Mueller et al., this is obvious because Mueller et al. teaches that any suitable polishing particles can be used and it is the examiners position that the lack of an abrasive size implies that any conventional size for the abrasive can be used as long as it provides the necessary abrasive action. In view of this, one skilled in the art would have found it obvious to use any known conventional abrasive size, such as the size defined by Tredinnick et al., as the abrasive particles size according to Mueller et al. because this abrasive particles size is conventionally known to provide the necessary abrasive action in polishing compositions. In addition, one skilled in the art would have appreciated the

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size required to achieve polishing, said size being conventional in the art, as is clearly shown by Tredinnick et al. Finally, one skilled in the art would have also known by routine experimentation and optimization the desired abrasive size needed to produce the desired abrasive character of the reference polishing composition.

Claim 2 is rejected under 35 U.S.C. 103(a) as obvious over JP 02262955 in view of Mueller et al. and Rysek et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claims 7, 8, 9 and 11 are rejected under 35 U.S.C. 103(a) as obvious over JP 02262955 in view of Mueller et al. and Rysek et al.

The use of the slurry defined by Mueller et al. is obvious in the according to the JP reference for the same reasons defined in the previous office action.

With respect to the amount of water (claim 8), although not literally defined by Mueller et al., when taking into consideration the ranges of the fluoride, amine, base and abrasive components, the amount of water can be calculated by subtracting this total amount from 100% (since the water is the balance of the composition). When this is done, the amount of water is within the claimed range.

With respect to claim 11, as defined above in the objection, the claim can be broadly interpreted to define that water is present (since water is a coolant). Since Mueller et al. contains this component (and the claim does not specify the type of coolant), it reads on the broad interpretation of claim 11.

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With respect to claim 7, with the claimed amount of water being obvious (see above-balance of the composition), when one calculates the mass ratio of the amount of amine to this amount of water, the claimed mass ratio is met.

With respect to claim 9, the JP reference clearly teaches a method which using this type of cutting.

New claim 6 is rejected under 35 U.S.C. 103(a) as obvious over JP 02262955 in view of Mueller et al. and Rysek et al., as applied to claim 2 above, and further in view of Tredinnick et al.

With respect to the abrasive size, although not defined by Mueller et al., this is obvious because Mueller et al. teaches that any suitable polishing particles can be used and it is the examiners position that the lack of an abrasive size implies that any conventional size for the abrasive can be used as long as it provides the necessary abrasive action. In view of this, one skilled in the art would have found it obvious to use any known conventional abrasive size, such as the size defined by Tredinnick et al., as the abrasive particles size according to Mueller et al. because this abrasive particles size is conventionally known to provide the necessary abrasive action in polishing compositions. In addition, one skilled in the art would have appreciated the size required to achieve polishing, said size being conventional in the art, as is clearly shown by Tredinnick et al. Finally, one skilled in the art would have also known by routine experimentation and optimization the desired abrasive size needed to produce the desired abrasive character of the reference polishing composition.

Applicant's arguments filed 5/25/06 have been fully considered but they are not persuasive.

With respect to the rejection of claim 1, applicants argue that Mueller et al. fails to teach the amount of amine relative to the amount of water and refers to the examples of this reference. With respect to any arguments based on the examples, it is well established that a reference is not limited to the disclosure in the examples. The examiner is aware that this reference does not literally define the amount of amine relative to the amount of water, however, although the amount of water in the composition according to Mueller et al. is not literally defined, when taking into consideration the ranges of the fluoride, amine, base and abrasive components, the amount of water can be calculated by subtracting this total amount from 100% (since the water is the balance of the composition). When this is done, the amount of water is within the claimed range of 10-40 %. With the amount of water being indirectly defined (by calculation), when one calculates the mass ratio of the amount of amine to this amount of water, the claimed mass ratio is met. Applicants also appear to argue that the specification on page 5 defines criticality for the claimed ratio. This is not persuasive because no results are shown.

With respect to the rejection of claim 2, applicants appear to argue on page 4, first 3 full paragraphs, that the JP reference and Rysek do not teach the claimed slurry. The examiner acknowledges this and has made an obviousness determination. It is improper to argue the references alone when a combination is made. With respect to Mueller et al., the claimed slurry is clearly suggested for the above reasons. With respect to the combination, applicants argue that the combination is improper because one skilled in the art from reading Rysek would not have appreciated that all slurries can be used interchangeably in polishing and cutting. The examiner

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is not relying on this reference to show that all polishing composition can be used interchangeably in polishing and cutting but rather to provide the proper motivation that the use of the alkaline based slurries of the JP reference and that of Muller et al. can either be used for cutting or polishing. This is clear because the JP reference teaches that alkaline-based abrasive slurries are used for cutting and similar alkaline-based abrasive slurries (Mueller et al.) are used for polishing. One skilled in the art from reading these two reference would have found the interchangeability between polishing and cutting obvious in view of these two reference which teaches that silica based alkaline slurry can be used for either cutting or polishing. Rysek was used as a linking reference to further establish this point. It is the examiners position that the desirability of the use of the Mueller et al. slurry for cutting has been clearly established in the previous office action and applicants arguments do not persuasively argue this point.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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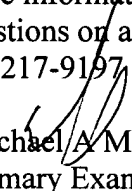
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/06  
MM

  
Michael A. Marcheschi  
Primary Examiner  
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